

REMARKS

The Examiner rejects claims 1-4 and 9-10 under 35 USC 103(a) as obvious over Seki et al (5,553,089) in view of Lear (5,633,527). Applicant respectfully traverses the §103 rejection because the office action has not established a *prima facie* case of obviousness. Accordingly, Applicant respectfully request that the Examiner withdraw the rejection of the claims.

"To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure."¹

Neither Seki nor Lear teaches or suggests all the claim limitations as amended. Further, the examiner has not applied the test of *Graham v. John Deere*² The MPEP requires the Examiner to do so.³ Nor has the Examiner has made a finding of the level of ordinary skill in the art.⁴ Nor is there a hint or suggestion to combine the two references.

None of the documents cited by the Examiner teaches alone or in combination with each other that a trench is introduced between the semiconductor laser element and the beam shaper and that the semiconductor laser element is a Fabry-Perot (FP) semiconductor laser element. This subject matter comprised in the presently pending independent claims 1 and 9 is not obvious for a person skilled in the art, with respect to the content of the prior art of record since the newly cited Seki is not relevant for the present invention.

Seki discloses *inter alia* in Figs. 7 to 10, and in particular Fig. 10, as well as in the corresponding description at col 5, lines 12 to 25, a laser bar combination 61, 62 joined by a solder layer 63 having side surfaces, which side surfaces are covered with end surface coats

¹ Id.

² 383 U.S. 1,148 USPQ 459 (1966)

³ MPEP § 2141

⁴ MPEP § 2141.03

61a and 64b, wherein "a convex lens 65 is fixedly attached to the outside of the end surface coat 64a" (col. 5, lines 23 and 24).

Contrary to the assumption of the Examiner and with respect to the picture shown on page 5 of the pending Office Action, Seki does not disclose a trench arranged between a semiconductor laser element and a beam shaper. The reference numeral 102 used in the pending office action and indicating a beam shaper is understood as the reference numeral 65 indicating a convex lens in Fig. 10 of Seki. Since a convex lens is also a beam shaper, it can be assumed that the convex lens of Seki and the beam shaper 203 shown in Fig. 2 of the present U.S. patent application have the same function. However, the reference numeral 100 used in the pending Office Action indicating a trench, is in fact the reference numeral 64a for the end surface coat in Fig. 10 of Seki and does not show a trench. Such an end surface coat always comprises solid-state material and usually has a certain thickness resulting in that the convex lens 65 in Fig. 10 of Seki does not directly touch the laser bar and solder layer combination 61 to 63 in Fig. 10 of Seki. Nowhere does Seki disclose a trench or are the reference numerals 60, 100 or 102 used to give the person skilled in the art any hint or suggestion to a trench.

Thus, the end surface coat 64a in Fig. 10 of Seki cannot be understood as a trench as necessary according to the subject matter of the presently pending independent claims 1 and 9 in the current invention. Claims 2-4 depend from claim 1 and claim 10 depends from claim 9 and, as a result, claims 1-4 and 9-10 are not rendered obvious in view of Seki.


The applicant respectfully requests the Examiner reconsider the rejection of claims 1-4 and 9-10 as obvious over Seki.

Moreover, with regard to Lear, there is nothing in Lear, nor any combination of Lear, including combination with Seki given the argument presented above, that would teach or give a person skilled in the art any hint or suggestion leading to claims 1-4 and 9-10 in the present application.

The applicant respectfully requests the Examiner reconsider the rejection of claims 1-4 and 9-10 as obvious over Seki in view of Lear.

Respectfully submitted,

Date: 3/2/04

By 
Jeffrey R. Stone (Reg. No. 47,976)
Attorneys for Applicant
BRIGGS & MORGAN, P.A.
2200 IDS Center
80 South Eighth Street
Minneapolis, MN 55402
(612) 977-8560